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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,055	03/14/2001	Norihisa Okada	503.39842X00	2640

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/24/2003

#12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,055

Applicant(s)

OKADA ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Withdrawal of Finality

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Withdrawn Rejections

2. The 35 U.S.C. 102 rejection of claims 1, 10, 12, 15, 17, 19, 21 and 22 of record in Paper #8, Pages 2-3, Paragraph #2 has been withdrawn due to the Applicant's argument in Paper #11.
3. The 35 U.S.C. 103 rejections of claims 11, 13, 14, 16, 18 and 20 of record in Paper #8, Pages 4-6, Paragraphs #5 and #6 have been withdrawn due to the Applicant's argument in Paper #11.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 12, 21 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Clark (2,774,699).

Regarding **claims 1 and 12**, Clark discloses a flat center core member having first and second major surfaces (Fig. 2, #26); a first flat face sheet (Fig. 2, #20) having a

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length substantially equal to a length of the flat center core member and being adhered to substantially all of the first major surface of the flat center core member; and a second flat face sheet (Fig. 2, #22) having a length shorter than the length of the flat center core member and having a first end portion adhered to a first end portion of the second major surface of the flat center core member, and a second end portion (Fig. 2, #30) including a second end terminating short of a second end of the flat center core member, the second end portion (Fig. 2, #30) of the second flat face sheet not being adhered to the second major surface of the flat center core member (Fig. 2, #26).

Regarding **claims 21 and 22**, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the

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limitation "by one of soldering, welding, and by an adhesive coating" is a method of production and therefore does not determine the patentability of the product itself.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 10, 11, 13 and 15-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (2,774,699).

Clark discloses the claimed invention except for the first flat face sheet being made of a material selected from the group consisting of metal, fiber reinforced plastic and paper, the flat center core being made of a material selected from the group consisting of a honeycomb-shaped paper, a honeycomb-shaped fiber reinforced plastic and a foam material, and the second flat face plate being made of a material selected from the group consisting of metal, fiber reinforced plastic and paper. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the first flat face sheet in Clark be made of a material selected from the group consisting of metal, fiber reinforced plastic and paper, the flat center core in Clark be made of a material selected from the group consisting of a honeycomb-shaped paper, a honeycomb-shaped fiber reinforced plastic and a foam material, and the second flat face plate in Clark be made of a material selected from the group consisting of metal, fiber reinforced plastic and paper, since it had been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. **Claims 14 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (2,774,699).

Clark discloses the claimed invention except for the thickness of each of the first and second flat face plates is in a range of about 0.5 mm-2.0 mm, and the thickness of the flat center core member is in a range of about 20 mm to 50 mm. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the thickness of each of the first and second flat face plates in Clark be in a range of about 0.5 mm-2.0 mm, and the thickness of the flat center core member in Clark be in a range of about 20 mm to 50 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absence of showing unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Response to Arguments

9. Applicant's arguments with respect to claims 1 and 10-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297. The examiner can normally be reached on 9:30-6:00.

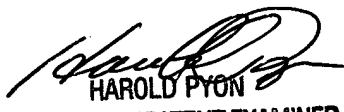
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone
Examiner
Art Unit 1772
August 27, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

8/28/03